

***IN THE UNITED STATES PATENT AND TRADEMARK OFFICE***

Applicant: Peter Altenschöpfung et al.

Title: TRANSDERMAL  
GRANISETRON

Appl. No.: 10/544,259

Patent No.: 7,608,282

Filing Date: 12/9/2005

Issue Date: 10/27/2009

Examiner: S. Tran

Art Unit: 1615

Conf. No.: 1348

**RENEWED**  
**REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT**  
**UNDER 37 C.F.R. §1.705**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Applicants respectfully renew their request for reconsideration of the Patent Term Adjustment (PTA) determined for the above captioned patent. The USPTO indicated in the communication mailed September 22, 2009, that a decision on Applicants' initial request was dismissed as premature until after the actual patent date. As noted above, the patent has now issued on October 27, 2009) as U.S. Patent No. 7,608,282.

The Patent Office determined that the patent was entitled to 260 days of PTA. Applicants believe that this PTA determination was made in accordance with the "Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. §154(b)(2)(A)" published at 69 Fed. Reg. 34238 (Jun. 21, 2004). Under that interpretation of the PTA statute, any PTO delay under 35 U.S.C. § 154(b)(1)(A) is deemed to overlap with any 3-

year maximum pendency delay under 35 U.S.C. § 154(b)(1)(B), and so, as a practical effect, PTA may be awarded under §154(b)(1)(A) or §154(b)(1)(B), but not both.

However, on September 30, 2008, the United States District Court for the District of Columbia issued a decision finding that the U.S. Patent and Trademark Office's interpretation of the PTA statute is incorrect. *Wyeth v. Dudas*, Civ. Action No. 07-1492 (JR) (Sep. 30, 2008). The court determined that, under the correct interpretation of the PTA statute, periods of "overlap" are limited to "periods of time . . . [that] occur on the same day." *Wyeth*, slip op. at 8. Thus, a PTO delay under §154(b)(1)(A) overlaps with a delay under §154(b)(1)(B) only if the delays "occur on the same day." *Id.*

Applicants have recalculated PTA for the captioned application under the court's interpretation of the PTA statute, and have determined that the patent is entitled to 353 days PTA, as shown on the attached sheet, which shows the relevant delays under 37 CFR §§1.702(a) and (b), and under 37 CFR §§1.703(a) and (b).

The attached sheet details the circumstances during the prosecution of the application resulting in the patent that constitute a failure to engage in reasonable efforts to conclude processing or examination of such application as set forth in § 1.704 .

(a) Total of non-overlapping PTO delay under §154(b)(1)(A) & (B):	496 days
(b) Total Applicant delay:	143 days
Final PTA Determination:	353 days

Applicants therefore respectfully request that the patent be accorded 353 days PTA.

The patent is not subject to a terminal disclaimer.

The requisite fee was previously paid along with the Request filed on July 14, 2009. While it is believed that no additional fees are due with this Renewed Petition, the Commissioner is authorized to charge any additional fees which may be required regarding this request, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by the credit card payment instructions in EFS-Web being incorrect or absent, resulting in a rejected or incorrect credit card transaction, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741.

However, because this PTA error is due to a Patent Office error in interpreting and applying the PTA statute, a refund of the fee is respectfully requested.

Applicants request further that a decision on this request be deferred or delayed until a final decision has been rendered in *Wyeth v. Dudas*, which is now on appeal at the U.S. Court of Appeals for the Federal Circuit, under Federal Circuit Docket No. 2009-1120.

Respectfully submitted,

Date 11/18/09

By Stephen E. Reiter


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Attorney for Applicant

### Patent Term Adjustment Calculation System

Docket Number: 041376-0801  
Application Number: 10/544299  
Patent Number: N/A

	Event Description	Event Date	Days from Filing	PTO Days	Applicant Days
<a href="#">Edit</a> <a href="#">Delete</a>	Priority Date	02/05/2003	-912		
<a href="#">Edit</a> <a href="#">Delete</a>	International Filing Date	02/05/2004	-547		
	PCT National Stage Commencement Date	08/05/2005	0		
<a href="#">Edit</a> <a href="#">Delete</a>	Notice to File Missing Parts	11/21/2005	108		
<a href="#">Edit</a> <a href="#">Delete</a>	National Stage Entry (All 371(c) Requirements Met)	12/09/2005	126		
<a href="#">Edit</a> <a href="#">Delete</a>	Response to Notice to File Missing Parts	12/09/2005	126		
<a href="#">Edit</a> <a href="#">Delete</a>	Application is Now Complete	12/24/2005	141		
<a href="#">Edit</a> <a href="#">Delete</a>	IDS NOT falling under 1.704(c)(6), (8) or (10) filed at PTO	04/07/2006	245		
<a href="#">Edit</a> <a href="#">Delete</a>	Preliminary Amendment under 1.704(c)(6) Received at PTO	01/24/2007	537		
	14 month From Application date	02/09/2007	553		
<a href="#">Edit</a> <a href="#">Delete</a>	Non-Final Office Action	03/18/2008	956	403	
<a href="#">Edit</a> <a href="#">Delete</a>	Non-Final Office Action Rsp. Rcv'd at PTO	04/02/2008	971		
<a href="#">Edit</a> <a href="#">Delete</a>	Final Office Action	07/07/2008	1,067		
	3 Year Period Starts	08/05/2008	1,096		
<a href="#">Edit</a> <a href="#">Delete</a>	Advisory Action	09/30/2008	1,152		
	Final Office Action + 3 months	10/07/2008	1,159		
<a href="#">Edit</a> <a href="#">Delete</a>	Request For Continued Examination (including amendment)	11/06/2008	1,189	93	30
	3 Year Period Stopped	11/06/2008	1,189		
<a href="#">Edit</a> <a href="#">Delete</a>	Non-Final Office Action	03/06/2009	1,309		
<a href="#">Edit</a> <a href="#">Delete</a>	Non-Final Office Action Rsp. Rcv'd at PTO	03/20/2009	1,323		
<a href="#">Edit</a> <a href="#">Delete</a>	Final Office Action	06/03/2009	1,398		
<a href="#">Edit</a> <a href="#">Delete</a>	Notice of Allowance	06/24/2009	1,419		
<a href="#">Edit</a> <a href="#">Delete</a>	IDS under 1.704(c)(10) filed at PTO	07/07/2009	1,432		

<a href="#">Edit</a> <a href="#">Delete</a>	Issue Fee Paid	07/14/2009	1,439		
<a href="#">Edit</a> <a href="#">Delete</a>	Patent Grant Date	10/27/2009	1,544		113
			Totals:	496	143
			PTA:	353	
<p>Created and maintained by</p>  <p><b>FOLEY</b></p> <p>FOLEY &amp; LARDNER LLP</p>					